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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/882,197	06/25/1997	PAUL GREER	42390.P4072	3875

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 05/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/882,197

Applicant(s)

GREER ET AL.

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6,9-13 and 17-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6,9-13 and 17-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

1. The request filed on March 20, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) is acceptable and a CPA has been established. An action on the CPA follows.

At Applicant's request, the After-Final Amendment filed on February 25, 2002 has been entered.

Claims 1, 7, 8, 14, and 16 have been cancelled by the Applicant.

Claims 2-6, 9-13, and 17-57 are pending.

Response to Arguments

2. Applicant's arguments filed March 20, 2002 have been fully considered but they are not persuasive.

Firstly, Applicant argues that there is no motivation within the cited references to establish a valid prima facie case to support the rejection under 35 U.S.C. 103; however, in response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner

combined teachings from Dedrick along with knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to establish a valid prima facie case in the rejection under 35 U.S.C. 103 (please refer to section 7 of paper no. 26 or the corresponding part of the art rejection found below).

Secondly, the Applicant implies that the art rejection does not address "a system and method to customize and target advertisements to particular audiences more likely to be interested in the particular advertisement or to which the advertising particularly pertains" in order to more effectively utilize bandwidth resources (page 9 of Applicant's After-Final response, paper no. 27). The Examiner respectfully submits that Dedrick does indeed speak to this concept. As a matter of fact, a similar argument was already addressed on page 3 of paper no. 26 and Applicant was directed to the following excerpts from Dedrick: Figure 3a; col. 3, lines 6-26; col. 4, lines 4-8; col. 9, lines 57-65; col. 10, line 62 through col. 11, line 33. In these excerpts, Dedrick discloses a metering service that is coupled to a local area network. Further, end user profile data is uploaded to the metering server. In one embodiment, the metering server has control over which content is delivered to the end user:

"In one embodiment, requests for information are made by the appraisal agent 28. In this embodiment, the metering process 36 checks whether the content database 34 contains information matching the search criteria provided by the appraisal agent 28. If a match exists, then electronic information is returned to the client system 12, provided the end user which initiated the appraisal agent 28 is a subscriber of the information, or has a sufficient balance in his or her account to pay for the electronic information."
(Dedrick: col. 10, line 62 through col. 11, line 33)

In conclusion, Applicant's arguments are not persuasive.

The following art rejection addresses pending claims 2-6, 9-13, and 17-57, as amended by the Applicant.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-6, 9-13, and 17-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (U.S. Patent No. 5,710,884).

As in the claimed invention, Dedrick teaches the use of agents to proactively target users with advertisements (i.e., content) that would likely be of interest to the users (as judged based on the user's updated profile). See at least col. 9, lines 3-46. This profile information is dynamic and is therefore constantly updated by the system (Abstract; col. 2, lines 15-29). Furthermore, it should also be noted that condition-action pair rules are inherent for the targeting of advertisements to occur. For example, such rules must incorporate logic along the lines of, "If user A has characteristic X, then send user A advertisement B." This is an example of a condition-action pair rule. The collection of rules (i.e., a rulebook) controls the overall operations of the advertisement-targeting system.

Regarding the concept of gathering user profile data (i.e., a user rule page) from the target computer and uploading it to the content provider, Dedrick discloses a metering service that is coupled to a local area network. Further, end user profile data is uploaded to the metering server. See at least Figure 3a; col. 3, lines 6-26; col. 4, lines 4-8; col. 9, lines 57-65; col. 10, line 62 through col. 11, line 33. In one embodiment, the metering server has control over which content is delivered to the end user:

“In one embodiment, requests for information are made by the appraisal agent 28. In this embodiment, the metering process 36 checks whether the content database 34 contains information matching the search criteria provided by the appraisal agent 28. If a match exists, then electronic information is returned to the client system 12, provided the end user which initiated the appraisal agent 28 is a subscriber of the information, or has a sufficient balance in his or her account to pay for the electronic information.”
(Dedrick: col. 10, line 62 through col. 11, line 33)

While Dedrick discloses the targeting of different information based on various rules applied to a user's profile, Dedrick does not explicitly outline every rule permutation possible. Claims 3, 4, 6, 9-11, 17-20, 23-25, 28, 32-34, and 37 address the characteristics of the target computer. Artisans of ordinary skill in the art have long known that it is common to collect data regarding a computer user's hardware and software in order to gather information about a computer user's hardware and software interests as well as to assist in establishing effective computer communications. For example, certain network protocols may need to be established for data transmission depending on a user's particular computer characteristics, including memory usage,

memory available, processor clock speed, operating system, modem speed, software, etc. As a matter of fact, a user's Internet and/or general networking capabilities are dependent on each of these factors; therefore, certain software may not even be compatible with the user's computer system. As a result, it would be a waste of time to attempt to download or even market products that are incompatible with a user's computer system to that particular user. Consequently, it would behoove an agent to be programmed to retrieve data regarding said hardware and software characteristics in order to effectively assess which information is to be targeted to which users, thereby making such an enhancement to Dedrick's invention obvious to one of ordinary skill in the art at the time of Applicant's invention.

As per claims 26, 35, and 36, while Dedrick gathers information concerning web sites visited by a user, he does not explicitly disclose that he records the time spent by the user at each web site; however, the Examiner asserts that such a limitation would be deemed obvious in light of the fact that artisans of ordinary skill in the art have long been aware of the correlation between a user's interest in a given topic and the time the user spends researching that topic. Therefore, the longer a user spends at a given web site, the more interest the user likely has in the information related with that particular web site. Consequently, an artisan of ordinary skill in the art at the time of Applicant's invention would have found it obvious to not only record information concerning the web sites visited by a user, but also to record the time spent at each web site in order to enable more effective targeting of information to a user based on a more accurate analysis of that user's interests.

As per claims 46, 47, 50, 51, 54, and 55, while Dedrick's agents collect profile information through a local area network (LAN) or a wide area network (WAN), Dedrick fails to explicitly disclose the collection of profile information through a web page via the Internet. However, the Examiner asserts that it is old and well-known in the art to collect profile information through a web page via the Internet. As a matter of fact, wide area networks are commonly implemented through the Internet in order to facilitate global connections. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enable Dedrick's agents to collect user profile information through a web site via the Internet in order to facilitate data collection from users throughout the world. All of the limitations of claims 5, 12, 22, 39, 40, 41, 46, 47, 50, 51, 54, and 55 are inherent to this Internet-enabled version of Dedrick's invention.

Regarding claims 48, 49, 52, 53, 56, and 57, Dedrick fails to disclose multiple content providers. However, Dedrick's system profits, at least in part, from its ability to charge for delivering targeted content to an end user; therefore, the more content providers there are available, the more likely Dedrick's system is to be profitable. Since different content providers likely provide different content services, the associated rule pages would be customized to each content provider based on information received from each of these content providers. As a result, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement Dedrick's invention with multiple content providers such that each provider is associated with a respective rule page based on information from each content

provider in order to widen Dedrick's market thereby increasing potential for profit while meeting the specific marketing needs of each content provider.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for Official communications, (703) 746-7048 for Non-Official communications, and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900 or to the Customer Service Office on (703) 306-5631.

SMD *SMD*
April 30, 2002

Joseph Thomas
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